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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,647	04/11/2001	Peter Slapnicher	REC-0401	1626

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EXAMINER

BUI, KIM T

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,647

Applicant(s)

SLAPNICHER, PETER

Examiner

Kim T. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/18/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4-12, 15, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- (A) As per claim 4, "said information" on line 1 lacks proper antecedent basis;
- (B) As per claim 6, " the services that said patient receives at the clinic" on line 3 lacks proper antecedent basis;
- (C) As per claim 7, "the time that the data will be useful" is indefinite;
- (D) As per claim 11, "said predetermined business" on line 1 lacks proper antecedent basis;
- (E) As per claim 15, "the services", "the products" on lines 2,3 lacks clear antecedent basis; "said clinic distributing said holder" on line 3 lacks proper antecedent basis;
- (F) As per claim 16, "the group" on line 2 lacks clear antecedent;
- (G) Dependent claims 5, 8-12 incorporate the deficiencies of the claims they depend on, and are therefore rejected.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure, as provided, fails to adequately describe the step(s) of processing and of performing an analysis based on data and information input on the Internet, as well as the structure(s) to perform these steps.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena), or software that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process

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must somehow apply, involve, use, or advance the technological arts. The body of the claim(s) must recite how the technological art is employed to produce a useful, concrete and tangible result in a non-trivial manner.

(A) In general, the claims 1-12 recite a method of doing business comprising the steps for providing holder and information, obtaining information, processing and performing an analysis, presenting and performing services (providing products) that do not involve, use or advance the technological arts. The recited database in the claim 7 may be a file storage that does not have to be in a computer, e.g., a file cabinet. The Internet recited in claims 2, 8 fail to recite how the technological art is employed to produce a useful, concrete and tangible result in a non-trivial manner.

In addition, for a claimed invention to be statutory, it must produce a useful, concrete, and tangible result. In the present case, the claimed invention recited in claims 1-12 for providing, obtaining, processing, performing an analysis, and presenting the analysis (i.e., repeatable) used in performing services and providing products (i.e., useful and tangible).

Although the recited process in claims 1-12 produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-12 deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbo (US2003/0195774) in view of Tung et al (5803499) and Podnar et al. (6108634).

(A) As per claim 1, Abbo discloses a business method in healthcare clinic comprising:

a. obtaining patient related information from the patient during the clinic visit. Abbo, page 3, paragraph 0031, paragraphs 0032, lines 1-2, page 2, paragraph 0029, lines 1-1-8.

b. processing said patient information during said clinic visit. Abbo, page 3, paragraph 0033, lines 1-9.

c. performing an analysis during the clinic visit to determine the best suitable product/services for the patient. Abbo, page 4, paragraphs 0041-0042, page 5, paragraph 0057, lines 12-13, page 6, paragraph 0062, lines 3-5.

d. presenting the analysis to the patient during the visit. Abbo, page 5, paragraph 0047.

e. performing and providing services and products to the patient. Abbo, page 6, paragraph 0068, lines 4-5, page 7, paragraph 0073, lines 10-11, paragraph 0080, lines 1-3.

As per the steps for providing folder and material for insertion in the folder. Abbo suggests on page 2, paragraph 0022, line 6, paragraph 0034, lines 8-10, and page 9, paragraph 0095 the material, the insertion to be provided to the patient and the

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availability of literature material for educational purposes. In addition, Tung et al teaches the steps for providing to the patient an information holder and inserted information, in a form of a marketing booklet, having information on the products and the service provider in the abstract, col. 3, lines 28-40, col. 4, lines 28-40. It would have been obvious to one having ordinary skill in the art at the time of the invention to include an information folder with the motivation of promoting and advertising the medical services/product provided to the patients. Tung et al, col. 5, lines 13-17.

Abbo fail to recite the "optometric clinic" in the preamble of the applicant's claim 1. This, however, is well known as evidenced by Polnar et al. Polnar et al teaches a clinical care patient analysis system for providing patient with vision care professional services. Polhar et al, the abstract, col. 1, lines 31-40. It would have been obvious to one having ordinary skill in the art at the time of the invention to include optometric clinical care with the motivation of expanding the applicability of the system. Pohar et al, col. 2, lines 19-24.

(B) As per claim 2, Abbo teaches the Internet and the use of the Internet material for medical analysis on page 2, pagrapraph 0023, page 9, paragraph 0095, lines 6-9, lines 32-34.

(C) As per claim 3, Abbo teaches that the processing and analyzing of information are performed prior to the determination of further services (i. e. follow up services)/products to the patient. Page 5, paragraph 0056. paragraphs 0050,0059.

(D) As per claims 4,5, Abbo teaches the information distributed to the patient and the medical literature, but fails to recite a business identification card. This, however, is well

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known as evidenced by Tung et al. Tung teaches an Information holder in a form of marketing booklet for distributing information to a recipient (i.e. patient) including a business identification information of the service providers (reads on business card). Tung et al., the abstract, col. 4, lines 30-33.

(E) As per claim 6, Abbo fails to expressly recite the order that coincides with the sequence of the provided services. However, it is logical that the information to the customer should be corresponding to the sequenced services and in order of the sequence to enhance the quality care and to facilitate the understanding by the patients and physician. For example, reports or instruction for diet, medication, exercise should be given prior to the distribution of the follow- up material for follow up services. Abbo, page 2, paragraph 0022, line 6, page 5, paragraph 0049, lines 1-6, paragraphs 0051, 0052, page 6, paragraph 0071, lines 1-5, paragraph 0072, lines 1-15.

9. Claims 7,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbo (US2003/0195774).

(A) As per claim 7, Abbo teaches a method for doing business, performed contemporaneously with a visit to or from a customer, for providing products and services to a customer, comprising the steps of:

a. providing information to the customer regarding the business, wherein the business provides services and/or products. Abbo, page 2, paragraph 0022, line 6, page 5, paragraphs 0049, lines 1-6, paragraphs 0051, 0052, page 6, paragraph 0071, lines 1-5, paragraph 0072, lines 1-15.

b. obtaining data and information from customer prior to the time the data will be useful in providing further services (i.e., follow up services) and/or products to said customer during the visit. Abbo, page 5, paragraph 0056, paragraphs 0050-0059.

c. entering data into a database. Abbo, page 6, paragraph 0070, lines 1-4, paragraph 0071, lines 7-10, page 9, paragraph 0096, lines 6-13, page 2, paragraph 0027, paragraph 0029, lines 3-17, page 3, paragraph 0031.

d. using the entered database to perform an analysis regarding what products and/or services would best meet the customer's needs and to provide a business recommendations. Abbo, page 3, paragraph 0029, lines 11-13, page 4, paragraphs 0041-0042, page 5, paragraph 0057, lines 12-13, page 6, paragraph 0062, lines 3-5.

e. presenting the analysis and the business's recommendation based on said analysis to said customer. Abbo, page 5, paragraph 0047, paragraphs 0050-0051.

Abbo fails to expressly recite the order that coincides with the sequence of the provided services. It is, however, readily apparent that the information should be presented to the customer corresponding to the sequenced services and in an order of the sequence. For example, questions are to be presented to the patient during the diagnosis phase, prior to the instructions, on diet and exercises, which are to be given during the treatment phase. In the same manner, follow up information and reminder, corresponding to the follow up services, should be given last in the sequence. It would have been obvious to one having ordinary skill in the art at the time of the invention to include "an order that coincides with sequence of provided services" with the motivation

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of facilitating the quality of patient care and the understanding of patients and physician.

Abbo, page 2, paragraph 0020, lines 15-17, page 5, paragraph 0055, lines 6-8.

(B) As per claim 8, the claim repeats the limitations of claim 2, and is rejected for the same reasons given above in the rejection of claim 2.

10. Claims 9, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbo, as applied to claim 7 above, and further in view of Tung et al. (5803499).

(A) As per claims 9,10, Abbo teaches the information distributed to the patient and the medical literature, but fails to business identification card. This, however, is well known as evidenced by Tung et al. Tung teaches an Information holder in a form of marketing booklet for distributing information to a recipient (i.e. patient) including a business identification information of the service providers (reads on business card).

Tung et al., the abstract, col. 4, lines 30-33. It would have been obvious to one having ordinary skill in the art at the time of the invention to include business identification information in form of a business card with the motivation of promoting or advertising the provided services/product. Tung et al, col. 5, lines 13-17.

11. Claims 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbo, as applied to claim 7 above, and further in view of Podnar (6108634).

(A) As per claim 11, Abbo fails to recite optometric business. It is, however, well known to provide vision care in the computerized medical data processing art, as evidenced by Podnar et al. Podnar et -al., the abstract, col. 1, lines 31-40. It would have been obvious to one having ordinary skill in the art at the time of the invention to include

optometric business with the motivation of with the motivation of expanding the applicability of the system. Podnar et al, col. 2, lines 19-24.

(B) As per claim 12, Abbo teaches the medical report and special instruction on lifestyle, diet, exercise on page 5, paragraph 0047, paragraph 0052, and education literature module on page 10, paragraph 0100. Regarding the eye health and vision report. This is disclosed in Podnar et al. the abstract, col. 1, lines 31-40, col. 6, lines 6-9.

12. Claims 13-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentile et al (4636179) in view of Williams (4571867) and Tung et al (5803499).

(A) As per claim 13, Gentile et al discloses an information folder for use in a business field comprising:

a. a folder having an interior and an exterior. Gentile et al, col. 4, lines 14 and 18.

b. a first interior side and a second interior side, located in the interior of the folder.

Gentile et al, Fig. 1, elements 34, 36, col. 4, lines 17-18.

c. a first flap and a second flap, extending from the bottom edge of the interior sides, the flap is for the containment of the insert. Gentile, col. 4, line 23, col. 6, line 1, col. 5, lines 62-64, Figs 1, 2, elements 42, 70, 67.

d. a plurality of angled slits 67 contained on flap 42, constructed and arranged for attachment of information cards. Gentile et al., Fig. 1, elements 42, 67, col. 5, lines 62-64.

e. information literature for insertion into the folder for promotional purpose. Gentile et al, col. 3, lines 45-52.

Gentile et al discloses angled slits on flap 42. It is unclear if the other interior side include slits. It is, however, well known to include a plurality of angled slits on both interior sides of the folder as evidenced by Williams. See Williams, Fig. 1, sides 15, 16, slits 21. It would have been obvious to one having ordinary skill in the art at the time of the invention to include a plurality of slits on both sides of the folder for holding various heights information literature with the motivation of facilitating the insertion of the flat articles. Williams, col. 3, lines 6-10.

Gentile et al does not expressly recite the "optometric field" as recited in the preamble of the Applicant's claim 1. However, it is well known to provide folder in the health care business field (i.e., vision care), to hold promotional or literature information, as evidenced by Tung et al. See Tung et al, col. 5, lines 35-55, col. 6, line 66 to col. 7, line 2, col. 9, lines 25-39. It would have been obvious to one having ordinary skill in the art at the time of the invention to include medical field (i.e., optometric) with the motivation of expanding the applicability of the folder disclosed by Gentile et al to include health-care business. See Tung et al, col. 3, lines 28-29.

(B) As per claims 14, 15, 20. Gentile et al teaches the information including a business card for identifying the name of the provider, the provided service(s) and product(s). See Gentile col. 3, lines 49-52, col. 5, lines 62-64. Gentile et al fails to expressly recite medical (i.e., optometric) field, lifestyle and healthcare report. These, are disclosed by Tung et al. on col. 9, lines 26-28, col. 7, lines 14-35. It would have been obvious to one having ordinary skill in the art at the time of the invention to include medical field (i.e., optometric) with the motivation of expanding the applicability of the

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folder disclosed by Gentile et al to include the health-care business. See Tung et al, col. 3, lines 28-29.

(C) As per claim 19, the flap(s), disclosed by Gentile, each has outside edge that is united with the edge of the interior side. See Figs 1, 2 of Gentile et al.

(D) As per claims 17-18, Gentile teaches first and second interior sides facing each other when the folder is folded in half along line 22, the flaps extend upwardly from the bottom of each sides, respectively. See Gentile, Figs, 1, and 2, elements 42, 70. 22, col. 4, lines 1-18. The folder is designed to hold information of various heights, for example, business card 68, filed promotional literature, Gentile, col. 3, lines 43-52, col. 5, lines 62-64. Gentile fails to expressly recite the dimensions (i.e. 12 inches by 9 inches folder and 4.25 inches flaps). It is, however, obvious to one having ordinary skill in the art within a level one having ordinary skill in the art at the time of the invention to vary the dimensions of the folder and flap with the motivation of providing flexibility in the design of the folder and the flap for accommodating the holding of desired distributed materials. Gentile et al., col. 3, lines 42-52.

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gentile et al (4636179) in view of Williams (4571867) and Tung et al (5803499) as applied to claim 13 above and further in view of Jackson (4621729).

(A) As per claim 16, Gentile fails to expressly recite the material of the folder.

Williams, however, teaches on col. 3, lines 43-45 that the folder can be constructed by any suitable material. In addition, Jackson teaches medical folder constructed by paper, plastic and light weighted cardboard on col. 3, lines 30-34. It would have been obvious

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to one having ordinary skill in the art at the time of the invention to include the material disclosed in Jackson with the motivation of providing a user the flexibility for constructing the device. Williams, col. 3, lines 43-45, Jackson, col. 3, lines 30-34.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. " Medical Network Management System" (5471382); " System For Scheduling and Reporting and Prioritizing Patient Services" (5065315); "Virtual Doctor Interaction System" (20020065682 A1); " Cardiovascular Healthcare System" (20030208108 A1) and "How marketing has paid off for these practices", Swannbrow, Siane, Medical Economics, v69, n17, p179 (6), Sept 7, 1992, Dialog File 148, Acc. no. 06157493.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Bui whose telephone number is 571-272-6768. The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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KTB



**ALEXANDER KALINOWSKI
PRIMARY EXAMINER**